



# UNITED STATES PATENT AND TRADEMARK OFFICE

*ck*  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,547	09/24/2003	Craig Stephen Slavtcheff	J6827(C)	4643

201 7590 04/05/2006

UNILEVER INTELLECTUAL PROPERTY GROUP  
700 SYLVAN AVENUE,  
BLDG C2 SOUTH  
ENGLEWOOD CLIFFS, NJ 07632-3100

EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
----------	--------------

1617

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/669,547

Applicant(s)

SLAVTCHEFF ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Receipt is acknowledged of amendment filed on January 5, 2006. Claims 1-17 are pending. Claim rejections made under 35 U.S.C. § 102 (b) and 103(a) as indicated in the previous Office action dated November 30, 2005 are withdrawn in view of claim amendment made by applicants. New rejections are made.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-6, 10, 11, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaHann et al. (US 4546112) ("LaHann") in view of Michaels et al. (US 3843780).**

LaHann discloses a method of preventing and/or reducing skin irritation caused by thioglycolate depilatory agent by applying capsaicin and/or its salts to the depilated area. See abstract. The reference specifies that the term "depilated area" there refers to the area which is, or is about to be, depilated by treatment with a thioglycolate depilatory agent. See col. 2, lines 41-43; instant claim 4. The reference teaches to formulate the anti-irritant composition in the form of lotions, creams, or solution, and also teaches using lipophilic emollients including hydrocarbon oils, silicone oils, and various natural and synthetic esters. See col. 3, line 9 – col. 5, line 57; instant claims 1 and 2. Example 3 illustrates the method of applying a composition comprising an anti-irritant composition, and subsequently applying the depilatory agent after 2 hours. See 5 and 6.

With respect to claim 10, the reference teaches that increase in the anti-irritation agent generally provided more effective irritation prevention or reduction in both the treated and untreated skin. See example 3. Thus it is viewed obvious that a skilled artisan would have adjusted the amount of the ratio of the pretreatment composition and depilatory composition with expectation that more amount of the pretreatment will more effectively prevent skin irritation caused by the depilatory agent.

While the reference generally teaches using an anti-irritant composition in the form of lotions, creams, solution, or gel, the reference does not teach an oil-based composition comprising 90-100 % of lipophilic materials.

Michaels teaches using mineral oil to make a pretreatment composition for shaving to provides comfort, soothing effect to the skin, and no irritation. See col. 1, lines 28 –56; Example 1. The reference teaches a formulation comprising 75-85 % of mineral oil and up to 2 % of emollient such as lanolin. See col. 1, line 11 – col. 2, line 45.

Michaels teaches using up to 87 % of lipophilic materials, while present claims 1 and 16 require at least 90 %. Claim 11 requires at least 98 % of lipophilic materials. Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” See *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235. In this case, the prior art teaches the general condition of the oil-based composition to

prevent skin irritation from shaving. It is viewed that a skilled artisan would have discovered by routine experiments the workable range of mineral oil and lanolin to make a composition comprising above 87 % of the oil ingredients.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of LaHann by using with an oil-based composition as motivated by Michaels and Flick because (i) LaHann teaches mineral oil as a suitable emollient for the composition; (ii) Michaels specifically teaches that the mineral oil-based composition provides comfort, smoothing effect to the skin with reduced or no irritation. The skilled artisan would have had a reasonable expectation of successfully producing a stable anti-irritant oily composition containing mineral oil which provides comfort and soothing effect to the skin.

With respect to claim 16, the transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See PPG Industries v. Guardian Industries, 156 F.3d at 1355, 48 USPQ2d at 1355. In this case, the phrase "consisting essentially of" is construed as "comprising" because there is no disclosure in the specification or claims that using 90-100 % of is the basic and novel characteristic of the present invention.

With respect to the phrase “the lipophilic materials protecting skin from redness/erythema”, it is viewed that practicing the prior art method of applying a pretreatment composition comprising the high content of lipophilic material would obvious result in the skin protection. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

**Claims 7, 12-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaHann in view of Michaels and Orlow et al. (US 6749840 B2).**

As discussed above, LaHann teaches the method of treating skin area to be, or that is, depilated with a composition comprising lipophilic emollient before or after applying a composition comprising thioglycolate depilatory agent. See instant claims 13 and 15. Since the reference teaches that the pre- or post-treatment anti-irritant composition comprises a dermatologically acceptable carrier, it is obvious that the topical depilatory agent composition is also provided by a suitable carrier. See instant claim 7 (b), (ii).

Also discussed above, Michaels teaches using a composition comprising up to 85 % of mineral oil and up to 2 % of lanolin to make a pretreatment composition for shaving to provides comfort, soothing effect to the skin, and no irritation. See col. 1, lines 28 –56; Example 1. See instant claim 14.

Michaels teaches using up to 87 % of lipophilic materials, while present claims 7 and 17 require at least 90 %. Claim 12 requires at least 98 % of lipophilic materials.

Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” See In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235. In this case, the prior art teaches the general condition of the oil-based composition to prevent skin irritation from shaving. It is viewed that a skilled artisan would have discovered by routine experiments the workable range of mineral oil and lanolin to make a composition comprising above 87 % of the oil ingredients.

With respect to claim 17, the transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. See In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” See PPG Industries v. Guardian Industries, 156 F.3d at 1355, 48 USPQ2d at 1355. In this case, the phrase “consisting essentially of” is construed as “comprising” because there is no disclosure in the specification or claims that using 90-100 % of is the basic and novel characteristic of the present invention.

Also in claim 17, with respect to the phrase “the lipophilic materials protecting skin from redness/erythema”, it is viewed that practicing the prior art method of applying

a pretreatment composition comprising the high content of lipophilic material would obvious result in the skin protection. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

LaHann does not specifically mention providing pretreatment composition and depilatory composition in a kit with a printed instruction insert in the kit.

Orlow teaches that it is a well known practice in personal care composition art to package the products with a printed instructions as a label or package insert directing the use of such composition. See col. 18, lines 43 – 56. See instant claim 7.

It would have been obvious to one of ordinary skill in the art at the time the present invention was made to modify the teachings of the combined references by packaging the anti-irritation composition and depilation composition with a printed instruction as motivated by Orlow because LaHann requires applying these compositions in sequence and Orlow teaches that a printed instruction is conventionally packaged with personal care products. The skilled artisan would have had a reasonable expectation of successfully producing a kit that would be helpful for the consumers to properly use the product in convenience.

**Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaHann, Michaels, and Orlow as applied to claims 7, 12-15, and 17 above, and further in view of Syed et al. (US 5756077) ("Syed").**

The combined references fail to teach adding textile materials to the kit.

Syed teaches hair protectant compositions. The reference teaches providing kits for a hair processing chemical composition and the protectant composition for the previously processed hair that are sequentially used. See col. 3, lines 12 – 32. The reference also teaches incorporating applicator, cotton (textile), and/or gloves. See col. 3, lines 24 – 32. See instant claims 8 and 9.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the kit of the combined references with applicators such as cotton or gloves as motivated by Syed because the reference teaches that it is well known in personal care art to insert applicators for the consumers to handle chemical treatment compositions. The skilled artisan would have had a reasonable expectation of successfully providing a depilation composition kit that can be safely and conveniently used by the consumers.

### ***Response to Arguments***

Applicant's arguments filed on January 5, 2006 have been fully considered but they are moot in part and not persuasive in part.

Applicants' arguments regarding the anticipation rejection made in view of LaHann is moot, as the rejection has been withdrawn in view of the applicants' claim amendment.

Applicants assert that the present invention is not prima facie obvious over LaHann, as applicants have applied a different concept from the prior art. The argument is moot in view of new grounds of rejection made in view of Michaels. The argument is also unpersuasive since the general idea of applying an anti-irritation

Art Unit: 1617

pretreatment composition comprising lipophilic phase before depilation was known at the time of the invention. The method of reducing skin irritation caused by hair removal by pre-applying mineral oil is also well known, as taught by Michaels. Thus the presently claimed invention is viewed obvious in view of the collective teachings of these references.

Applicants assert that there is "a significant difference between shaving and depilatory treatment". The argument is unpersuasive because there is no evidence that the skin irritations caused by depilatory treatment requires a different treatment than the skin irritation caused by shaving. In response to applicant's argument that Michaels is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Michaels, LaHann, and applicants are concerned with reducing skin irritation caused by hair removal procedures.

Applicants' argument that Michaels' invention is limited to using no more than 85 % of mineral oil is moot in view of the new ground of rejection as discussed above.

Applicants' argument that Syed fails to remedy the deficiency of LaHann is moot in view of the new ground of rejection, which was prompted by the claim amendment.

Applicants' arguments regarding the application of In re Ngai decision are moot in view of the new ground of rejection, which was prompted by the claim amendments. See 70 U.S.P.Q. 2d 1862, C.A.F.C. 2004.

***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 9:00AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner



**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**